

REMARKS

This communication responds to the Office Action mailed on October 5, 2007. Claims 21 and 24 are amended, no claims are canceled, and no claims are added. As a result, claims 1-46 are now pending in this Application.

Objections to the Specification

The Office has objected to the title of the application as not being descriptive. The title of the Application is now amended to read: TRANSMITTING UNCONFIRMED COMPUTING PLATFORM SERVICE INFORMATION. It is believed that the amended title obviates the objection lodged by the Office. However, if further amendment is requested, the Applicant would be pleased to comply.

The Office has requested that the Applicant provide a Brief Summary of the Invention in the specification. However, the Applicant respectfully submits that the inclusion of this section is optional, since neither the rules nor the patent statute requires a patent applicant to provide this kind of summary. As discussed in 37 CFR § 1.73:

“A brief summary of the invention indicating its nature and substance, which may include a statement of the object of the invention, *should* precede the detailed description. Such summary should, *when set forth*, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.” (emphasis added)

The language of the Code, including use of the word “should” and the phrase “when set forth,” indicates that inclusion of a summary section is optional, rather than mandatory. Indeed, the Applicant is unaware of any legal requirement upon which providing, or amending the specification to provide, a summary of the Invention would be based. Therefore, the Applicant respectfully declines to amend the specification to include a summary, and requests that the objection be withdrawn.

§102 Rejection of the Claims

Claims 1-46 were rejected under 35 U.S.C. § 102(e) for anticipation by Sorvari et al. (U.S. 2004/0043758; hereinafter “Sorvari”). The Applicant does not admit that Sorvari is prior art and reserves the right to swear behind this reference at a later date. In addition, because the Office has not properly established a *prima facie* case of anticipation, the Applicant respectfully traverses this rejection of the claims.

Anticipation under 35 USC § 102 requires the disclosure in a single prior art reference of each element of the claim under consideration. *See Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). “The *identical invention* must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131 (emphasis added).

Independent claim 1 is directed to a method comprising:

periodically **transmitting, without confirmation**, a part of the at least a portion of the computing platform service information to at least one potential subscriber to the at least one service.

Similar language is used in independent claims 21, 29, and 39. The Office asserts that this element is taught by Sorvari at pages 23-24, paragraphs [0307 – 0309]. However, the Applicant can find nothing in Sorvari, or any other evidence in the record, to indicate that such is the case.

Sorvari teaches that:

“when a wireless device accesses services, data pertaining to the service access, along with any context related information is transmitted within the wireless device, or to a remote server. The data is processed in conjunction with

bookmarks/short-cuts specified within the device, and are organized and presented to the wireless device in accordance with preference instructions specified within the wireless device. *See* Sorvari, Abstract.

That is, Sorvari operates by transmitting *with confirmation* to a wireless device. Indeed, every embodiment reviewed by the Applicant involves prior messaging by the wireless device. *See e.g.*, Sorvari, paragraphs [0086], [0088], [0095], [0100], [0123], [0307], [0309], [0342]-[0344], as well as independent claims 1, 23, 45, and 67. As a matter of contrast, what is claimed and taught by the Applicant is explained in the specification as follows:

“Any potential subscriber ... might then obtain a summary of services offered within the selected range area without having to discover (or make connection with) every service provider in the vicinity. In this example, the PDA may choose to listen for all services available in the store, using the WSB broadcast information to fill in gaps in service offerings, or the PDA may choose to listen only to brokers broadcasting in the store. ... The transmission module 138, capable of being communicatively coupled to the memory module 134, may be used to transmit (with or **without confirmation by any listening device**) at least a part 158 of the solicited or unsolicited computing platform service information 142 to one or more potential subscribers 162 to the respective service. In other words, some portion (or all) of the stored information 142 may be broadcast to various potential subscribers 162, such as PDAs, cellular telephones, laptops, etc.” Application, pg. 3, lines 8-16 and pg. 5, line 29 – pg. 6, line 5.

Nothing in Sorvari would lead one of ordinary skill in the art to teach unconfirmed service discovery by wireless devices, because Sorvari describes extensive use of context sensitive web services that rely on the wireless device to sense the user’s environment “and in response, to provide recommendations to the user that is appropriate to the user’s environment and that can be accessed by the user’s command or other form of user input.” *See* Sorvari, Title, and paragraph [0233].

Therefore, since Sorvari does not teach the identical invention claimed by the Applicant, independent claims 1, 21, 29, and 39 (and all claims depending from them) should be in condition for allowance. Reconsideration and withdrawal of the rejection under § 102 is therefore respectfully requested.

§101 Rejection of the Claims

Claims 21-28 were rejected under 35 U.S.C. § 101 because it was asserted that the claimed invention is directed to non-statutory subject matter. The Applicant respectfully traverses the rejection, since no *prima-facie* case of non-statutory subject matter has been established.

However, in order to expedite prosecution of this matter, and not for reasons related to patentability, the Applicant has amended independent claim 21 as nearly as possible to follow the suggestion offered by the Office, so as to recite: “An article comprising a tangible computer-readable medium containing computer-executable instructions which, when executed, results in a machine performing ...”. Claim 24 has been amended to conform to this new language, and not for reasons related to patentability.

Thus, claim 21, and all claims depending therefrom, recite a tangible medium having executable instructions stored thereon. This makes clear that the invention claimed resides in the statutory category of an article of manufacture. The Applicant therefore respectfully requests reconsideration and withdrawal of the rejection of claims 21-28 under 35 U.S.C. § 101.

Reservation of Rights

In the interest of clarity and brevity, Applicant may not have equally addressed every assertion made in the Office Action, however, this does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner’s personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in

support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

CONCLUSION

The Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the Applicant's attorney at (210) 308-5677 to facilitate prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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